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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,017	04/09/2007	Franz-Josef Becker	FLGDK26.002APC	7024
20995 7590 07/14/2010 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER CORDRAY, DENNIS R	
			ART UNIT 1791	PAPER NUMBER
			NOTIFICATION DATE 07/14/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/575,017	<b>Applicant(s)</b> BECKER ET AL.	
	<b>Examiner</b> DENNIS CORDRAY	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's amendments and arguments, filed 4/29/2010, have overcome the following rejections for reasons given in the remarks (see pp 4-6):

Claims 1-8 and 18 under 35 U.S.C. 102(b) or under 35 U.S.C. 103(a) over Auhorn et al;

Claims 9-17 and 19 under 35 U.S.C. 103(a) over Auhorn et al in view of others;

Claims 1, 2 and 4-19 under 35 U.S.C. 102(b) or under 35 U.S.C. 103(a) over Ogawa et al.

The indicated rejections have been withdrawn.

Applicant's arguments regarding the rejections based on Darsillo et al have been fully considered but they are not persuasive.

Regarding the failure of Darsillo et al to disclose examples having the claimed composition, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) Furthermore, "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

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Darsillo et al does not specify a coating weight outside of the examples. One of ordinary skill in the art would have been guided to use 15 gsm as a coating weight (as used in the examples) with any of the coating compositions embodied by the disclosure.

Darsillo et al teaches that the compositions can comprise a surfactant, but does not specify an amount of surfactant outside of the examples. One of ordinary skill in the art would have been guided to use a surfactant in the amount of 1 part by weight (as used in the examples) with any of the coating compositions embodied by the disclosure.

The compositions and application amount of coating embodied by Darsillo et al overlay the claimed compositions and application amount, and the papers will have the printability and haptic characteristics of the claimed papers because, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "Products of identical chemical composition can not have mutually exclusive properties."

The rejections based on Darsillo et al are maintained, but have been modified to address the amended claims.

***Claim Rejections - 35 USC § 102 and 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8 and 14-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Darsillo et al (US 2002/0004131) as evidenced by Stoye et al.

Claims 1, 2, 5, 6, 7 and 8: Darsillo et al discloses a recording medium comprising a paper substrate having a glossy coating thereon. The glossy coating comprises a binder and first and second groups of particles. The first group comprises metal oxide particles having a size less than 100 nm in diameter and aggregates of the particles having a diameter from about 100 nm to about 500 nm. The second group comprises metal oxide or semimetal oxide particles having a mean diameter less than about 50% of the aggregates (Abs; p 1, pars 8-13; p 2, par 27; p 5, pars 58-59). The particles in each group have an overall cationic, nonionic or anionic charge (p 3, par 44). The glossy coating can comprise a surfactant and other additives (p 6, par 63). A partial coating is not disclosed, thus the entire surface is coated or, at least, coating the entire surface would have been obvious to obtain a uniform paper and uniform printing properties.

In examples, a coating weight of 15 g/m<sup>2</sup> was applied (p 11, Examples 10-13). The amount of binder is from about 1% to about 50% of the composition (dry binder and particles combined), which overlays the claimed range (p 7, par 78). Combined with the

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disclosed coating weight, an amount of pigment particles within the claimed range can be calculated.

Claim 3: In some examples, an amount of surfactant used is 1% of the amount of pigment, thus a weight of surfactant within the claimed range can be calculated (p 11, Table 8; p 12, Table 12).

Claim 4: Cationic, anionic and nonionic surfactants are disclosed (p 6, par 63).

Claims 14-17: Darsillo et al discloses that the substrate can have more than one coating layer, which can be the same (p 2, par 38), thus, a second layer having the claimed composition and coated onto the first is embodied.

Claims 18 and 19: Darsillo et al discloses a method of making the recording medium comprising coating the substrate to provide a coated substrate (p 1, par 15).

Claims 9-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Darsillo et al in view of Moreland and as evidenced by Stoye et al ("Paints, Coatings and Solvents").

The disclosure of Darsillo et al is used as above. Darsillo et al does not disclose that the paper substrate comprises a filler or other additives.

Moreland discloses that conventional fillers used in paper are precipitated or ground calcium carbonate (reads on chalk), talc, clay, titanium dioxide, calcium sulfate (gypsum), silicates, etc. to fill voids in the paper and to enhance the appearance of the printed page (col 3, lines 22-30). Other conventional additives used in paper include

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binders, dispersants, fluidity improvers, thickening agents, defoamers, dyes and other coloring agents, strengthening agents, etc. (col 3, lines 32-46).

The art of Darsillo et al, Moreland and the instant invention is analogous as pertaining to papers used for printing. It would have been obvious to one of ordinary skill in the art to include the claimed fillers and other additives in the paper substrate of Darsillo et al in view of Moreland as conventional components in printing paper. Many of the disclosed fillers have the claimed oil number (see Stoye et al, pp 154-155, Table 4.2) or, at least, obtaining the claimed values would have been obvious to one of ordinary skill in the art from the values in Stoye et al. The fillers have cavity volumes as revealed by the disclosed oil numbers.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DENNIS CORDRAY whose telephone number is (571)272-8244. The examiner can normally be reached on M - F, 7:30 -4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Cordray/  
Examiner, Art Unit 1791

/Eric Hug/  
Primary Examiner, Art Unit 1791